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EXAMINER

HARRELL, ROBERT B

ART UNIT PAPER NUMBER

2142

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/535,279

Applicant(s)

LU ET AL.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005 et al.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 12-40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-40 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 08 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20051024.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: see attached Office Action.

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1. The applicant's Election (filed 8/25/2004) of claims 1-40 (GROUP I) is again hereby acknowledged. Group II contained claims 41-62 and Group III contained 63-85. Since the applicant has failed to specifically declare the Election as one with or without traverse and since there is/are no rebuttals of the Election by the applicant, the Election is treated as an election without traverse. Therefor, the restriction requirements (mailed 7/21/2004) is/are hereby incorporated in this action in totality as maintained with Group I being claims 1-40, Group II being claims 41-62, and Group III being claims 63-85 and made FINAL.

2. Claims 1-4 and 12-40 remain presented for examination with claims 5-11 cancelled and with claims 41-85 withdrawn from further consideration as non-elected inventions.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. The Substitute Specification filed 15 December 2005 is acceptable. However, related application information within the Specification (e.g., see pages 43-44) must be updated with current information (i.e., Now Abandoned, Now United States Patent (number), still pending, exc...). The applicant has failed to indicate that the Substitute Specification contains no New Matter and is thus required to do so in the response to this Office Action.

5. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

6. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-4 and 12-40 are rejected under 35 U.S.C 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear for the reasons outlined below.

8. Per claim 3 "the known network", claim 27 "the available local subnet address (last line), claim 32 (line 8) "the network (see lines 3 and 6 of claim 32), claim 34 (line 7) "the network node" (see lines 1 and 7 of claim 34), claim 38 (line 5) "the network node" (see claim 38 (lines 2 and 4), and "The means" in claim 40 are but a few examples of numerous cases where clear

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antecedent basis are lacking and not an exhausting recital. Any other term(s) or phrase(s) overlooked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent basis also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introductions of a term, or changes in tense, results in a lack of clear antecedent basis for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent basis are lacking can be viewed as non-responsive. Nonetheless, should a response yield all claims allowable short *a few* cases where clear antecedent basis are lacking within the claims, a preemptive authorization to enter an examiner's amendment to the record to correct such would accelerate a notice of allowance over a final rejection. Such could be added at the end of an applicant's response with the following statement: "Examiner is hereby authorized, without the need of further contact by examiner, to enter an Examiner's Amendment to correct any cases where antecedent basis are lacking." if the applicant so elects. This does not diminish the applicant's requirement to correct all such cases not so listed in the example few given above nor prohibit any amendments after a notice of allowance by the applicant.

9. Per claim 1, it is not clearly certain if "network address information" on lines (5 and 12-13) are one and the same or different network address information.

10. Per claim 26, it cannot be clearly ascertain from lines 5-7 if the second network node is or is not external from the local subnet nor does "permanent" give a temporal boundary since nothing is permanent.

11. Per claim 29, it cannot be clearly ascertained if "A network node" (line 1) is also the "interrogating network node" of line 3.

12. Per claim 29, it cannot be clearly ascertained what is considered by nodes on the subnet as being external from the subnet (i.e., the interrogating node or the IP address).

13. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions. Thus, in light of the ambiguities under 25 U.S.C. 112, second paragraph as cited above and to the best examiner is able to understand the claimed invention in light of the specification giving the claims their broadest reasonable interpretation, the following is forwarded.

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14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

15. Claims 26-28 and claims 32-40 are rejected under 35 U.S.C. 102 (e) as being anticipated by Reid (United States Patent Number: US 6,233,616 B1).

16. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

17. Per claim 26, Reid taught a method (e.g., see col. 2 (line 19)) of retrieving a permanent network configuration (e.g., see Abstract) by a first network node (e.g., see figure 1 (101)), the method comprising the steps of:

- a) determining an available local subnet configuration by the first network node (e.g., device 101 of figure 1) in a local subnet (e.g., see col. 3 (lines 58-63));
- b) accessing a second network node (e.g., see figure 1 (120)) considered by nodes (e.g., those of LAN 102)) in the local subnet (e.g., LAN 102 of figure 1) as being external (e.g., see figure 1 (LAN 130) from the local subnet for an available permanent network configuration (e.g., see col. 4 (LINE 37 "207.43.165.41")) from a list (e.g., see figure 4 (TABLE 1)) of permanent network configurations; and
- c) assigning the available permanent network configuration to the first network node (e.g., see col. 4 (line 63-et seq.)).

18. Per claim 27 and claim 28, such was covered in col. 4 as cited above when the device 101 (of figure 1) communicated with the DHCP via router 108.

19. Per claims 32-40, such do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above in that until device 101

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obtains an IP address indicated in col. 4, the device is considered not apart of the current subnet LAN 102 with the DHCP 120 as a processing device for automatically assigning a network configuration to a network node.

20. Pending claims not withdrawn and not mentioned above under 35 U.S.C. 102 stand allowable over the art of record since the art of record fails to teach or remotely suggest posing as a network node having an IP address considered by nodes on the subnet as being external from the subnet in the manner so claimed.

21. **A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).**

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142